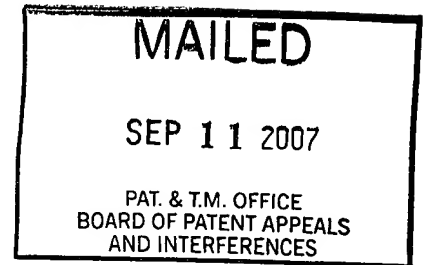


1 RECORD OF ORAL HEARING  
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3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
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10 Ex parte DAVID GREENBLATT  
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12  
13 Appeal 2007-1232  
14 Application 09/575,707  
15 Technology Center 2100  
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18 Oral Hearing Held: August 8, 2007  
19  
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21  
22 Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and  
23 ST. JOHN COURTENAY III, Administrative Patent Judges  
24

25 ON BEHALF OF THE APPELLANT:  
26

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33 The above-entitled matter came on for hearing on Wednesday, August  
34 8, 2007, commencing at 9:01 a.m., at the U.S. Patent and Trademark Office,  
35 600 Dulany Street, Courtroom B, Alexandria, Virginia, before Jennifer M.  
36 O'Connor, Notary Public.

37 JUDGE DIXON: Good morning, Mr. Casey.

1 DR. CASEY: Good morning.

2 JUDGE COURTENAY: I'd like to welcome you to the board. Have  
3 you been here before?

4 DR. CASEY: Not this room, the other room before Judge Lee and a  
5 couple other judges for an interference not too long ago.

6 JUDGE COURTENAY: You have 20 minutes and if we ask  
7 questions, we may extend your time a few minutes to compensate.

8 DR. CASEY: Thank you. In previous appeals, I have tried to make  
9 sure that if there are any open questions they get answered, and as you said,  
10 I've been interrupted many times and would look forward to questions.

11 This case is particularly one of those cases where the issue has been  
12 focused on a few occasions. I've tried to focus the issue on the fact that the  
13 examiner is trying to modify a reference in a way that will change its  
14 principle of operation. I tried to bring that out during the prosecution. I  
15 never really got an answer from the examiner as to why he was making this  
16 modification. In fact, in the examiner's answer, he doesn't address the fact  
17 that yet again, I've pointed out, he's changing the principle of operation.

18 The result that we got back was, essentially from the examiner, he can  
19 look at the invention as a whole and then didn't address whether or not he  
20 really was changing the principle of operation. I'd like try to talk a few  
21 minutes about why the principle of operation of one of the major references  
22 is being changed.

23 I hope that will point to why this is potentially non-obvious. There  
24 are other factors as well, but that's certainly the most overarching of all the  
25 factors.

1           The 615 patent, DaGolia, is a reference which enabled  
2   communications to be made across the Internet. They were voiceover IP  
3   calls, which are essentially what this invention by the applicant could be  
4   used for.

5           The idea is that in DaGolia, the 615 patent, the person who was  
6   involved in developing a Web page, if he wanted to enable people to  
7   communicate with the person responsible for the Web page, he would  
8   actually have to update his Web site in order to make sure that the person  
9   would know that they could communicate with the other side; it would be a  
10   button, as in figure 3, where they say, receive a call back from PSTN or  
11   make a service agent IP call or sales H&IP call.

12          But those things all get embedded into the Web page and the problem  
13   that's solved by the applicant's invention is that the applicant's invention  
14   monitors what is being viewed by the Web page, and as a result, can then go  
15   make a query to find out whether or not the URL that's being displayed,  
16   either in independent claim 1 in the address bar, or in independent claims 52  
17   to 54, doesn't say where the URL is because there are other embodiments  
18   where it can be in the history file or some other place.

19          But it's essentially an active process where it looks at what URL is  
20   being displayed by the Web page currently, makes a query, and then  
21   determines whether or not a phone number is available for it, and if so,  
22   indicates that to the user without requiring user intervention.

23          The advantage over something like DaGolia, the 615 patent, is that  
24   number one, a third party could be responsible for identifying whether or not  
25   there's a phone number that you could contact somebody who's responsible  
26   for the Web page. For example, if inside the Patent Office people were

1 having trouble using Google and you wanted the person who's having  
2 trouble to be able to contact the Patent Office help desk, that would be  
3 possible under the applicant's invention because you're looking at the Web  
4 bar or the URL that's being looked at presently, and you don't have to be  
5 updating the Web page. It's not like the Patent Office has to go to Google  
6 and say, hey, when you get a query from somebody at the Patent Office  
7 would you put a link down at the bottom that says they can contact us at the  
8 Patent Office Web support in order to know how to use Google?

9 The reality is that because you do this phonetically, you look at the  
10 URL that's being displayed; you can separate the function of who you call  
11 from what are you looking at. That's one of the major distinctions between  
12 the applicant's invention and DaGolia, and one of the reasons that we pushed  
13 so hard throughout the prosecution history, to understand why the examiner  
14 was taking DaGolia, which could already make connections, and already had  
15 embedded in it one fashion or another the ability to make calls, and then  
16 modified it, essentially it seemed to me, taking back out the very thing that  
17 DaGolia taught in order to be able to look at the URL instead.

18 One of the things that I always was wondering about was, was the  
19 examiner being confused by the fact that somehow DaGolia must have that  
20 step of knowing what the user's looking at on the Web page inherently. I  
21 think that there are two answers to that. The first is the second step, is the  
22 converting step. If you are saying that the person must inherently already  
23 know the phone number associated with the Web page being displayed,  
24 there would be no converting step. There's no process by which you would  
25 do a conversion if you're saying the number being on the page in and of  
26 itself means that the number is known for that URL.

1           The second is that URLs are independent of the content that is on the  
2 page. For example, if I had a URL that was named ABC.html, I could  
3 change it to XYZ.html, and then still have the same phone number be  
4 associated with it. As a result, the phone number that's associated inside a  
5 Web page is disjoint from the URL itself. So there would be no way to say  
6 that the system of DaGolia was in fact associated with the URL with the  
7 phone number that's inside it, because those two things can change  
8 independently.

9           Those were the points that we were trying to raise in the whole change  
10 of the principle of operation. If you had comments on whether or not you  
11 thought the examiner was in fact tacitly admitting that he was changing the  
12 principle of operation, maybe we would know that this is an issue that we  
13 don't really have to deal with. But if that's a question I can ask, I'd like to do  
14 so.

15           JUDGE BLANKENSHIP: It looks like the examiner may be using  
16 DaGolia just to show essentially the final three lines of claim 1.

17           DR. CASEY: The three lines, visually identifying without user  
18 intervention of the telephone numbers known for the informed resource  
19 locator, yes, that gets to the last point I was trying to raise which is, because  
20 you can change the URL and you can change the information in the Web  
21 page independently, DaGolia can't actually visually identify whether the  
22 telephone number is known for that URL, because the URL can change  
23 independent of the telephone number that's in there.

24           As a result, it also brings us back to the question in the second step,  
25 whether or not you're doing a conversation from the URL into a telephone  
26 number. If in fact what the system of DaGolia is doing is there is a

1 telephone number embedded in it, then it raises the question of why on earth  
2 would you combine it with the other references, the Voit reference for  
3 example, which does a conversion?

4 If the examiner's point was that DaGolia didn't need to do a  
5 conversion because the information was already embedded in the Web page,  
6 then there would be no reason to match it with the system of Voit, which  
7 does a conversion from the URL to a telephone number. It's already got a  
8 telephone number; why are these two things coming together? What's the  
9 motivation for making this change to the two systems to bring them  
10 together?

11 If the conversion step is to mean anything, I think it has to mean that  
12 there was originally something other than the telephone number that was  
13 ultimately converted into the telephone number instead of simply saying,  
14 well I have a telephone number stuck under this Web page and therefore, I'm  
15 going to visually identify that yes, I do have a telephone number stuck on  
16 this Web page. It becomes almost circular.

17 That's the problem I had with the combination of the references. Voit  
18 was taking a domain name and/or a URL and converting into a telephone  
19 number. DaGolia was representing that telephone number was on the Web  
20 page because it's on the Web page. But if those two things are true, then  
21 where is the need to make the marriage?

22 As a result, I think that what you see is that neither Voit nor DaGolia  
23 even saw the problem that the applicants were trying to address, which was  
24 the ability to, without having to reengineer Web pages, be able to identify to  
25 people that a phone number was known for this Web page. It could be done  
26 by a third party. It could be done by the Web page person itself.

1 JUDGE BLANKENSHIP: Does the prior art have to solve that same  
2 problem?

3 DR. CASEY: It doesn't, Your Honor, but it has to be solving some  
4 problem. The thing that is difficult sometimes in computer cases is, you can  
5 program a computer to do anything and you can program a computer to have  
6 as many different features as you want on any one particular application.  
7 But it's knowing what the combination should be that makes an invention an  
8 invention.

9 You could combine things for other reasons, potentially not for the  
10 same reason here, but it has to be a reason that you can point to, something  
11 other than what the patent examiner said, for example, in the claims later  
12 that address the longest matching substring. He says, well I'm going to say  
13 that it's obvious to do a partial match of the URL with the longest matching  
14 substring in the database because it would make processing faster.

15 Well, that's true any time you use less information; the processing is  
16 going to be faster. But that doesn't mean somebody's going to be motivated  
17 to do it. There has to be an expectation of success. Looking at the  
18 references themselves, I don't see any expectation of success that the  
19 modification would provide anything better than what was there before.

20 We're talking about people who are followers of teachings. What  
21 does it fairly suggest to them, not the innovators. The innovator was the  
22 applicant here who said, you know what, I can get a real benefit if I separate  
23 out this processing, if I take what I can find out the person is looking at and  
24 convert it into a telephone number. I can tell that person if there's technical  
25 support or sales or whatever without having to do anything, without having  
26 to reengineer Web pages, being able to make this third party independent.

1           The Patent Office could have one number that is called because of a  
2   URL. My law firm could have another. The result is that you get an  
3   extreme advantage over DaGolia, where somebody would have to go back  
4   and reengineer each of these pages if they were going to have a Patent  
5   Office specific Web site versus a law firm specific Web site.

6           JUDGE BLANKENSHIP: But as an initial matter it seems like it  
7   would be obvious to display information that would be useful to any user?

8           DR. CASEY: That's a truism.

9           JUDGE BLANKENSHIP: Isn't that common sense?

10          DR. CASEY: I guess the first question is, how do you know what  
11   information is going to be important to users? The Worldwide Web has  
12   been around since the early nineties. There is lots of information that would  
13   be helpful to users that could have been displayed on the Web.

14          The question is, how do you know what that information is? Aren't  
15   we taking the applicant's specification where he says, hey you know what, if  
16   there's a problem with this Web page, then this is how you can contact  
17   somebody to tell you about it, or if there's information about it.

18          Your Honor, I guess the easiest way for me to address it is, if it was  
19   obvious to go ahead and make this kind of important information available  
20   and visible to users, people wouldn't have taken the time to do what DaGolia  
21   is doing and actually embedded it into the Web sites. Why not? Because it's  
22   an incredible waste of resources, designing your Web page such that it's got  
23   stuck into it information that might have to be changed and might require a  
24   whole reengineering of the Web page, versus being able to change it from a  
25   day to day somewhere else?



1 JUDGE DIXON: But doesn't DaGolia just show that that is  
2 information of interest, whereas Voit then shows you can get that  
3 information other places? And then common sense is well, DaGolia shows  
4 displaying it, why not then display what we've been converting?

5 That seemed to be what the examiner was saying, that DaGolia goes  
6 to; go ahead and display it, but not embedded necessarily. Voit shows  
7 converting it or determining it. The combination of them is, you can find it  
8 from other sources, go ahead. It is useful because otherwise DaGolia  
9 wouldn't have done that. Your argument to if there's technical difficulties or  
10 other aspects, I don't see it in the claim. Independent claim 1 is very generic  
11 as to you get the information, you display the information.

12 There is no field of use, endeavor to problems on the Web page, so  
13 why then, if the information is desirable, and you can get it from another  
14 source, it seems like, go ahead and display it, for marketing, for whatever  
15 aspects, it saves space on the page. Common sense would be, we don't have  
16 to put it there, we can convert it. Because Voit shows that we can find that  
17 information, some other conversion methodology, or look up in a directory  
18 conversion, something like that. That seemed to be what the examiner's  
19 position was.

20 DR. CASEY: If I understood you, the way I understand, it's almost as  
21 if you've taken the examiner's rejection and flipped it around and said okay,  
22 well it's start with DaGolia first, and maybe he should have because maybe it  
23 was closer, and now we'll add Voit.

24 If you do it that way, then you run into a different problem, which is,  
25 if I've got DaGolia and I've got the information that's stored in the Web  
26 page, and I've already got a phone number, why do I need Voit?

1 JUDGE DIXON: Because you don't need to store it. You don't need  
2 to display it on the screen. You can have another mechanism. You only  
3 have so much space on the Web page.

4 DR. CASEY: But Voit doesn't solve that problem. Voit solves the  
5 problem of being able to make a conversion from a textual name over to a  
6 telephone number. The information that you're seeing in DaGolia doesn't  
7 tell you whether or not this is stored as a telephone number or as a URL.

8 If it's already stored as a telephone number, there's no need to make a  
9 change. If it's stored as a URL, then maybe you can make the conversion,  
10 but you're still going to display the same information. He hasn't figured out  
11 that there's a way to separate these two, because the query he would make,  
12 even if he made a query of hey, what's the telephone number for this  
13 dynamic, would be, I'm going to click on this link. I've got a textual string;  
14 I'll use the Voit system to convert it to a telephone number. But then what?

15 It's too late. It's too late because the processing that goes on goes on  
16 when you look at the URL itself. By the time this page is displayed, it's  
17 already rendered everything that's associated with the page. How does  
18 DaGolia know oh, now I need to go out and get this other information that I  
19 could have been embedded in my Web page, but I didn't?

20 He doesn't even see that this is an issue. He doesn't even see you  
21 could save the space. That's why he uses the space.

22 JUDGE COURTENAY: You're essentially arguing hindsight. Would  
23 you like to address hindsight and why the KSR and the idea of common  
24 sense, litigating hindsight?

25 DR. CASEY: Sure. The issue that arises with computers  
26 is--unfortunately in the computer programming world, there's a famous

1 expression that every problem in computer science can be solved with one  
2 more level of indirection, which means, you can always go get information  
3 from one other place and add more information.

4 The question is, how do you judge whether or not it's common sense  
5 in order to determine what applicants have done? Applicants have pointed  
6 to the fact that there's a savings. If it was common sense to make this  
7 change, then why would DaGolia and all the other people who have built  
8 Web pages that say, contact the Web master about this particular Web page,  
9 click here, why would they all go through the trouble of building in the  
10 systems that you have to manually add, or even have a computer add to the  
11 Web page, information saying that you can get information about this Web  
12 page from another place?

13 If you think of all the time that people have spent dealing with the fact  
14 that they need to embed into the Web page information to tell you about the  
15 Web page, when they could have simply done it by looking at what Web  
16 page is the person looking at in the Web browser?

17 You see that all those people who have been wrong can't have all been  
18 wrong if this was common sense. It's one of those inventions where you're  
19 right, after you've seen it you kind of hit your head and go, well yeah. But it  
20 wasn't until somebody said, hey, if you do the processing this way, if you  
21 look at what Web page the person is looking at and then you convert it to a  
22 telephone number, then you can give the person an indication about whether  
23 or not they can communicate with someone.

24 It's a very simple process and I believe, Your Honor is correct, it's a  
25 rather broad claim. But the difference is, that it's taking the problem and  
26 turning it upside down, looking at it from such a different angle that the only

1 way that this can be obvious is by looking at the applicant's specification,  
2 which is the definition of not obvious.

3 As I mentioned before, as to some of the dependent claims which are  
4 argued separately also, it's again a yes, you can process less information and  
5 it might be more efficient. Is it common sense to do it? Well, probably not  
6 if there are other reasons why it might not work. Where is the expectation of  
7 success?

8 JUDGE BLANKENSHIP: Back to claim 1, suppose we take out the  
9 last three lines of claim 1 and we discard DaGolia, is there anything wrong  
10 with the combination applied against the rest of claim 1 for the first two  
11 references?

12 DR. CASEY: Not having thought about that as a rejection before, I  
13 can give you my initial comments.

14 JUDGE BLANKENSHIP: One way to read the answer is that the  
15 examiner is just using DaGolia for essentially the display, the last three  
16 lines. We take away the display, the visual identification, and there's these  
17 other things left in the claim and these other two references applied against  
18 that, so is there something wrong with that combination against these other  
19 limitations in claim 1?

20 DR. CASEY: I think that the same hindsight reconstruction issue  
21 would be there. For example, the secondary reference is Haitsuka, which is  
22 really there simply to say that you can monitor what a person is looking at in  
23 the Web browser. There is a mechanism by which you can figure out what  
24 the person is looking at or has looked at.

25 If that's the case, then that may be a useful tool in the toolbox, but  
26 there's no indication that you would then merge that with say Voit to say

1 okay, well the person looked at the Web site XYZ.com; let's convert that to a  
2 telephone number, to what end? Haitsuka does advertising monitoring.

3 JUDGE BLANKENSHIP: It does the monitoring to send advertising,  
4 so might you want to send the telephone number to the Web page that the  
5 person is looking at?

6 DR. CASEY: Certainly the applicants thought you might. I don't  
7 know if others would even see that that was an issue. But here's the reason  
8 why. If they were going to send that information over, the telephone number  
9 of the Web site the person was looking at, how did people know that that  
10 was something you wanted to do?

11 You could already do that in the Web page. You could send over the  
12 information in the Web page itself just like DaGolia does. The question  
13 becomes how does one looking at Haitsuka and its advertising, say oh, one  
14 of the things that I want to send instead of advertising is in fact the  
15 information where you might contact this person.

16 JUDGE BLANKENSHIP: That doesn't sound like it would be instead  
17 of; it would be part of the advertising.

18 DR. CASEY: Your Honor, there are lots of advertisements out there  
19 and I can't tell you that one of ordinary skill in the art would have  
20 understood that to be part of what would have been sent. Again, part of the  
21 reason is because if the advertising is being sent over, how is the  
22 advertisement connected to the URL that the person is looking at?

23 The URL that the person is looking at might give, like the sense of  
24 Google, when you enter some key words, you just enter plumbing and  
25 hardware and they put ads on the right-hand side, Home Depot and places  
26 that you might be able to get that, in addition to the other information you

1 send. But in that case, they're not using the URL that the person is looking  
2 at in order to send that advertising information.

3 JUDGE BLANKENSHIP: It's almost a secondary—

4 DR. CASEY: The key is in the key word search. I'm sorry.

5 JUDGE BLANKENSHIP: Excuse me, is that what the secondary  
6 reference is saying, that the advertising is never related to the Web page  
7 that's being viewed?

8 DR. CASEY: I don't remember looking at it for that particular aspect.  
9 I don't have a recollection that the advertisement being sent was based on the  
10 URL that the person was looking at such that you would be able to know, as  
11 in the first two steps, what the URL was and then the conversion of the URL  
12 that you're looking at to a telephone number corresponding to location at  
13 which a provider of the Web page can be contacted.

14 In fact if it was an advertising, it would almost seem to be the other  
15 way around. The advertisement is something that might be displayed for a  
16 lot of different things and if the advertisement was for Home Depot while  
17 you were looking at a Google Web page, then you wouldn't be sending to  
18 the user Google's telephone number as part of the Home Depot ad; they don't  
19 go together that way.

20 JUDGE DIXON: Counsel, your time is just about up. Do you have  
21 any concluding remarks?

22 DR. CASEY: No, Your Honor. I think that this is one of those cases  
23 where the changes to the references are the best indication that the  
24 combination is not obvious, and as a result, things like the benefits that are  
25 obtained by the invention, like the ability to have third parties manage this

1 data, the ability to not have to reengineer Web pages, are the best evidence  
2 that in fact this is based on hindsight.

3 JUDGE DIXON: Any further questions? Thank you.

4 JUDGE COURTENAY: Thank you, very much.

5 (Whereupon, at 9:30 a.m., the hearing was adjourned.)

6

7